

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 82-107 were pending in the application of which Claims 82, 95, 98, 100, 102 and 104 are independent. In the Office Action dated January 7, 2009, claims 82-92, 94, 95, 97, 98, 100 and 104 are rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,367,078 (Lasky) in view of U.S. Patent No. 6,760,537 (Mankovitz). Claim 93 is rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,367,078 (Lasky) in view of U.S. Patent No. 6,760,537 (Mankovitz) as applied to claim 82, and in further view of U.S. Patent No. 5,585,078 (Amano). Claims 96, 99, 101-103 and 105 are rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,367,078 (Lasky) in view of U.S. Patent No. 6,760,537 (Mankovitz) as applied to claim 95, and in further view of U.S. Patent No. 5,673,089 (Yuen). Applicants hereby address the Examiner's rejections in turn.

Claim Rejections – 35 U.S.C. § 103

2. Rejection of Claims 82-92, 94, 95, 97, 98, 100 and 104

The Examiner rejected claims 82-92, 94, 95, 97, 98, 100 and 104 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,367,078 (Lasky) in view of U.S. Patent No. 6,760,537 (Mankovitz). Applicant respectfully traverses the Examiner's rejection.

Applicants first submit that, for a *prima facie* case of obviousness, the cited prior art references (when combined) "must teach or suggest all the claim limitations" MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness, can show that the cited prior art references (when combined) do not teach or

suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record. The Lasky reference provides the following:

“The *program-guide database* contains a record for each program, and each record has information for its program in fields as illustrated in FIG. 6A. *The channel-number field 611 contains the number of the channel on which the program is scheduled to appear. There is also at least a title field 612, a first time slot field 613, a start offset in minutes 614, a length in 30-minute time slots 615, an end offset in minutes 616, and a category field 617.* The start offset is the delay from the start of the first time slot to the start of the program. The end offset is the delay from the end of the last time slot until the end of the program. The EPG system does not assume that programs are assigned to a fixed list of categories or even to a fixed list of channels. The contents of a preferred embodiment of the program-guide database are entirely determined by a master program guide that is received from the television-distribution network at a data decoder 32. However, an illustrative list of categories is Movies (all), Sports (all), Specials (all), Series (Children, Comedy, Drama, other), News (Business, Current, General Interest, Sports, Weather) and Shopping. A data-input module 56 uses channel, title, time-slot and category information in the master program guide to fill in records in the program-guide data base and discards other information.”

See col. 5, line 64-col. 6, line 19, emphasis in italics added. A review of the above illustrates that the Lasky reference teaches a database having a plurality of records and each record having a plurality of multi-bit data fields. The data fields include channel number, title, first time slot, start offset, length, end offset and a category field. Each of these data fields are comprised of multiple bits. This is to be distinguished from the bit mask of the channel table as claimed in amended claims 82, 95, 98, 100, 102, 104, and 107 where the bit mask is comprised

of a plurality of single bits where each bit of the bit mask refers to one distinct category of a plurality of predetermined categories and wherein the respective value at which each bit is set indicates whether or not the one distinct category corresponding to that bit is assigned to the respective channel associated with the bit mask. As set forth in prior communications, it is Applicants contention that Mankovitz does not disclose that a record comprises a *listing* of channels. Whereas amended claims 82, 95, 98, 100, 102, 104, and 107 recites where each bit of the bit mask refers to one distinct category of a plurality of predetermined categories and wherein the respective value at which each bit is set indicates whether or not the one distinct category corresponding to that bit is assigned to the respective channel associated with the bit mask, Mankovitz appears to utilize several fields to cover more than one category (i.e., one field does not equate to several categories). Accordingly, the claimed features are simply not disclosed. In the Office Action, the Examiner asserts that “the claim limitations do not require that each bit field correspond to several categories. The claims only states that each bit of the bit mask refers to a predetermined category (singular).” Applicant respectfully submits that claims 82, 95, 98, 100, 102, 104, and 107 as amended specifically set for that each bit of the bits mask refers to one distinct category or a plurality of categories (plural). In view of the above comments and the amendment to claim 82, 95, 98, 100, 102, 104, and 107, Applicant respectfully requests reconsideration of claim 82, 95, 98, 100, 102, 104, and 107 and the withdrawal of the rejection of claim 82, 95, 98, 100, 102, 104, and 107 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,367,078 (Lasky) in view of U.S. Patent No. 6,760,537 (Mankovitz). Applicant respectfully submits that claim 82, 95, 98, 100, 102, 104, and 107 are in condition for allowance.

Because independent claim 82 is allowable over the Lasky reference in view of the Mankovitz reference, dependent claims 83-92 and 94 are allowable as a matter of law for at least the reason that the dependent claims 83-92 and 94 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Because independent claim 95 is allowable over the Lasky reference in view of the Mankovitz reference, dependent claims 96 is allowable as a matter of law for at least the reason that dependent claim 96 contain all elements of its respective base claim. Because independent claim 98 is allowable over the Lasky reference in view of the Mankovitz reference, dependent claims 99 is allowable as a matter of law for at least the reason that dependent claim 99 contain all elements of its respective base claim. Because independent claim 100 is allowable over the Lasky reference in view of the Mankovitz reference, dependent claims 101 is allowable as a matter of law for at least the reason that dependent claim 101 contain all elements of its respective base claim. Because independent claim 102 is allowable over the Lasky reference in view of the Mankovitz reference, dependent claims 103 is allowable as a matter of law for at least the reason that dependent claim 103 contain all elements of its respective base claim. Because independent claim 104 is allowable over the Lasky reference in view of the Mankovitz reference, dependent claims 105 is allowable as a matter of law for at least the reason that dependent claim 105 contain all elements of its respective base claim.

3. Rejection of Claim 93

Claim 93 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Lasky (US 6,367,078) in view of Mankovitz (US 6,760,537), further in view of Amano (US 5,585,865).

Claim 93 depends from claim 82. As shown above, Lasky in view of Mankovitz fails to teach, suggest or make obvious to one of ordinary skill all of the claim limitations of claim 82. Amano fails to correct the deficiency in the teachings of Lasky in view of Mankovitz. Namely, Lasky in view of Mankovitz, further in view of Amano fails to teach, suggest or make obvious a bit mask comprised of a plurality of single bits where each bit of the bit mask is associated with a channel category and the value of each bit indicates whether the respective channel is associated with that channel category. Furthermore, claim 93 depends from an allowable base claim and as such is allowable. As the Court noted in *In re Fine*, “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Therefore, Applicants respectfully submit that because independent claim 82 is now nonobvious, claim 93 is also nonobvious and is now in a form for allowance.

4. Claims 96, 99, 101-103 and 105

Claims 96, 99, 101-103 and 105 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Lasky (US 6,367,078)) in view of Mankovitz (US 6,760,537), further in view of Yuen (US 5,673,089).

Claim 96 depends from claim 95. Claim 99 depends from claim 98. Claim 101 depends from claim 100, and claim 105 depends from claim 104. As shown above, Lasky in view of Mankovitz fails to teach, suggest or make obvious to one of ordinary skill all of the claim limitations of claims 95, 98, 100 and 104. Yuen fails to correct the deficiency in the teachings of Lasky in view of Mankovitz. Namely, Lasky in view of Mankovitz, further in view of Yuen fails to teach, suggest or make obvious a bit mask comprised of a plurality of single bits where each bit of the bit mask is associated with a channel category and the value of each bit indicates whether the respective channel is associated with that channel category. Furthermore, claims 96, 99, 101 and 103 each depend from an allowable base claim and as such is allowable. As the Court noted in *In re Fine*, “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Therefore, Applicants respectfully submit that because independent claims 95,

98, 100 and 104 are now nonobvious, claims 96, 99, 101 and 103 are also nonobvious and are now in a form for allowance.

Claim 102 is an independent claim and claim 103 depends from claim 102. Yuen fails to teach or suggest a bit mask comprised of a plurality of single bits where each bit of the bit mask is associated with a specific and distinct channel category and the value of each bit indicates whether the respective channel is associated with that specific channel category. Therefore, Yuen fails to correct the deficiencies of Lasky and Mankovitz, and as such, Lasky and Mankovitz, further in view of Yuen, alone or in any combination, fail to teach suggest or make obvious all of the limitations of independent claim 102, as amended, and subsequently fails to teach, suggest or make obvious all the limitations of claim 103, which depends from claim 102. Therefore these claims are in a form for allowance over the cited references.

Furthermore, claim 103 now depends from an allowable base claim and as such is allowable. As the Court noted in *In re Fine*, “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Therefore, Applicants respectfully submit that because independent claim 102 is now nonobvious, claim 103 is also nonobvious and is now in a form for allowance.

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int’l Co. v. Teleflex, Inc.* (KSR), No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int'l Co.*, at 14, 15. This requirement prevents the use of “the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicants submit that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). It would not have been obvious to one of ordinary skill in the art to combine Lasky in view of Mankovitz as both references, together or alone, fail to teach, suggest or make obvious tone of ordinary skill in the art a channel table as disclosed and claimed in the present application. In particular Lasky in view of Mankovitz, further on view of Amano or Yuen fail to teach, suggest or make obvious a bit mask comprised of a plurality of single bits where each bit of the bit mask is associated with a channel category and the value of each bit indicates whether the respective channel is associated with that channel category. Applicants earnestly request reconsideration, withdrawal of these rejections, and allowance of claims 82-105.

CONCLUSION

Applicants respectfully request that this Amendment After Final be entered by the Examiner, placing the claims in condition for allowance. Applicants respectfully submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants respectfully submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants respectfully submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In view of the foregoing, Applicants respectfully submit that the pending claims, as amended, are patentable over the cited references. The preceding arguments are based only on the arguments in the Official Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 19-0761.

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